

REMARKS

In the Office Action dated August 25, 2003, claims 2 and 3 were deemed allowable. Claims 8-11 stand rejected under 35 U.S.C. §112, first paragraph. Claims 1, 4-7 and 12-15 stand rejected as anticipated under 35 U.S.C. §102(b) by U.S. Patent No. 5,139,878 to Kim et al. (hereinafter “Kim”). Likewise, claims 8-10 stand rejected as anticipated under 35 U.S.C. §102(b) by U.S. Patent No. 4,857,400 to Kloss Jr. (hereinafter “Kloss Jr.”) Lastly, claim 11 has been rejected as obvious under 35 U.S.C. §103(a) over Kloss Jr. in view of U.S. Patent No. 5,533,452 to Mouri et. al (hereinafter “Mouri”).

In response, Applicants have cancelled claim 1, have amended claims 2, 4-8 and 12-15, and have amended the specification. These amendments when considered with the remarks set forth below are deemed to place the application in condition for allowance. Claims 4-15 remain pending for continued examination. Withdrawal of the rejection of claims 4-15 is respectfully requested.

Rejection Of Claims 8-11 Under 35 U.S.C. §112, First Paragraph

Claims 8-11 stand rejected for lack of enablement, because the specification, “while being enabling for a carrier film wherein the drawn polyester film has a thickness of 5-300  $\mu\text{m}$ , does not reasonably provide enablement for a carrier film wherein the drawn polyester film has a thickness above this range.” See Office Action at page 2.

In response, Applicant have amended claim 8 to recite a laminated carrier film comprising a drawn polyester film having a thickness of 5 to 300  $\mu\text{m}$ . Support for this amendment is found at page 7, lines 12-18 of the specification. Thus, no new matter is being added by this amendment. Withdrawal of the rejection is respectfully requested.

Rejection Of Claims 4-7 And 12-15 Under 35 U.S.C. §102(b) Based On Kim

Claims 4-7 and 12-15 stand rejected as being anticipated by Kim. See Office Action at page 2. In response, claim 1 has been cancelled, and claims 4-7 and 12-15 have been amended to depend solely from independent claim 2, which has been deemed allowable. In view of the above, withdrawal of the rejection of claims 4-7 and 12-15 is respectfully requested.

Rejection Of Claims 8-10 Under 35 U.S.C. §102(b) Based On Kloss, Jr.

Independent claim 8 and dependent claims 9-10 stand rejected as anticipated by Kloss Jr. See Office Action at page 3. The Examiner states that Kloss Jr. discloses a polymeric release layer and a polymeric stabilizing layer, where the release layer is comprised of a fluororesin and the stabilizing layer is preferably biaxially oriented polyethylene terephthalate. Applicants respectfully submit that independent claim 8, as amended, and dependent claims 9 and 10 are not anticipated by Kloss Jr.

First, Kloss Jr. does not anticipate the present invention because it does not disclose each and every element of claims 8, 9, or 10. While Kloss Jr. discloses a sheet containing a polymeric release layer and a polymeric stabilizing layer (see Office Action at page 3), Kloss Jr. does not disclose an embodiment of a carrier film comprised of a drawn polyester film with a fluororesin laminated on at least one side of the drawn polyester film.

Beyond disclosing all of the claimed elements in isolation, Applicants respectfully point out that anticipation “requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.” Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984). Stated otherwise, anticipation does not occur where the claimed elements are disclosed in

isolated parts of the reference instead of in an embodiment that meets all the elements of the claim.

While Kloss Jr. discloses a polymeric stabilizing layer that “is selected from polyimides, polyesters, polyethersulfones, and preferably, biaxially oriented polyethyleneterephthalates” (column 2, lines 62-64) and discloses a polymeric release layer that “is selected from polyvinylfluorides, polytetrafluoroethylenes, polysiloxanes and other polymers with similar release properties”(column 2, lines 58-61), the Examiner has not pointed out in Kloss Jr. a single embodiment that meets each and every element of claim 8. Applicants respectfully point out that, while the Kloss Jr. reference may be cited as anticipatory prior art against claims 8-10, the Kloss Jr. reference in and of itself does not disclose an embodiment that reads on claims 8-10. Thus, Kloss Jr. cannot anticipate claim 8 and dependent claims 9 and 10. Applicants respectfully request that the rejection of claims 8-10 be withdrawn.

Second, the Kloss Jr. reference does not inherently anticipate claims 8-10, since the Examiner has failed to show how the Kloss patent meets a maximum/minimum thickness differential of less than 5  $\mu\text{m}$ . Claim 8 requires “a carrier film having a difference between a maximum thickness and a minimum thickness of 5  $\mu\text{m}$  or smaller.” See claim 8.

The Examiner contends that Kloss Jr. “should” meet this limitation, which appears to be an attempt to show that this element of claims is inherent. See Office Action at page 4. However, in order to prove inherency, the Examiner must show that one of ordinary skill in the art viewing the reference would understand that the unmentioned feature at issue is necessarily present in the reference. Continental Can Co., U.S.A. v. Monsanto Co., 948 F.2d at 1268-69, 20 USPQ2d 1746, 1749-50 (Fed. Cir. 1991 ). In Continental Can, the Federal Circuit noted that

“[i]nherency...may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient.” (emphasis added) *Id.* at 1749-50. Thus, “should” merely alludes to a probability that does not meet the requisite burden of establishing inherency.

In the present case, the suggestion that “[s]ince Kloss [Jr.] uses an oriented polyethylene terephthalate film which has a thickness of less than 300  $\mu\text{m}$  as their stabilizing layer, the difference between maximum and minimum thicknesses of the stabilizing layer should meet the limitations of claims 8 and 9” (see Office Action at 4) suggests that a difference between minimum and maximum thickness of  $<5 \mu\text{m}$  may result from the Kloss Jr. process, not that such a difference of  $<5 \mu\text{m}$  will result. In view of the above, withdrawal of the rejection of claims 8-10 is respectfully requested.

Rejection of claim 11 under 35 U.S.C. §103(a)

Dependent claim 11 stands rejected as obvious in light of Kloss Jr. and Mouri. It is the examiner’s contention that Kloss meets all of the elements of claim 11 except for specifying that the polymeric release layer comprises a tetrafluoroethylene-ethylene copolymer, and the use of a tetrafluoroethylene-ethylene copolymer (as disclosed by Mouri) in this process would be obvious to one skilled in the art. See Office Action at page 4.

In response, Applicants respectfully submit that a prima facie case of obviousness has not been set forth. As set forth in Section 2142 of the M.P.E.P., a prima facie case of obviousness requires three basic criteria to be met:

First, there must be some suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skilled in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable

expectation of success. Finally, the prior art reference (or references when combined), must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, and not on the applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1981)(emphasis added).

First, the Office Action fails to recite any motivation or suggestion as to why one skilled in the art would make the above-cited combination in an attempt to achieve the claimed invention. The statement that all the elements are known and customary in the art does not indicate why one skilled in the art would make the specific above-cited combination. As set forth in Section 2143.01 of the M.P.E.P., “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” Thus, there must be some motivation or suggestion for making the combination, otherwise the rejection is improper. The Examiner’s contention that Mouri discloses that polytetrafluoroethylene and tetrafluoroethylene-ethylene are known in the art to be equivalent materials (see Office Action at 5) fails to address any motivation (in either the Mouri or the Kloss Jr. patent) for one skilled in the art to combine these two references.

Second, the Office Action fails to recite how one skilled in the art would have a reasonable expectation of success in achieving Applicant’s claimed invention. As noted *infra*, Kloss Jr. does not disclose a single embodiment that anticipates claims 8-10. Since Kloss Jr. does not anticipate claim 8 or embody claim 8, it is unclear how a person skilled in the art would have a reasonable expectation of success in achieving the requisite differential between minimum and maximum thickness of less than 5  $\mu\text{m}$  by combining the Kloss Jr. and Mouri

references. Thus, it is respectfully submitted that the obviousness rejection to claim 11 be withdrawn.

Lastly, the above-cited combination fails to teach or suggest all the elements of Applicants' claimed invention. As noted *infra*, the Kloss Jr. patent does not inherently disclose a difference between maximum and minimum thickness of the carrier film of less than 5  $\mu$ m. This narrow differential of carrier film thickness is a requisite element of claim 8. Thus, any assertion that the Kloss Jr. and Mouri patents teach a carrier laminate film having a differential of less than 5  $\mu$ m is not supported by the prior art and represents an attempt to bootstrap an inherency argument (found impermissible in the anticipation context) into the obviousness context. Likewise, the Mouri reference is silent as to the differential between maximum and minimum thickness of the carrier layer. A combination of the Kloss Jr. and Mouri references will not yield all of the elements of Claim 11, and the examiner thus does not show how combination of the Kloss Jr. and Mouri references will yield all of the elements of Claim 11.

Therefore, it is respectfully submitted that the Examiner has failed to demonstrate a prima facie case for an obviousness rejection of claim 11. First, the Office Action did not provide a suggestion or motivation for combining the Mouri and Kloss Jr. patents. Second, the Office Action did not articulate a reasonable expectation of success arising from combination of these references. Finally, the Office Action did not show that a combination of the Mouri and Kloss Jr. references would disclose all elements of claim 11. In light of the above, withdrawal of rejection of claim 11 is respectfully requested.

In view of the above amendments and remarks, Applicants respectfully submit that the application is in condition for allowance which action is earnestly solicited. If for any reason the

application is not deemed in condition for allowance, the Examiner is respectfully requested to contact the undersigned attorney, so that additional amendments may be entered as necessary.

Applicants do not believe that any fees are due with this response. However, if any fees are due, please charge such sums to our Deposit Account 50-1145.

Respectfully submitted,



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